

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/780,270  
Filed: February 17, 2004  
Inventors:  
Michael S. Bender, et al.

Examiner: Farrokh, Hashem  
Group/Art Unit: 2187  
Atty. Dkt. No: 5681-76100

\*\*\*\*CERTIFICATE OF E-FILING TRANSMISSION\*\*\*\*

Robert C. Kowert

Printed Name \_\_\_\_\_

/Robert C. Kowert/  
Signature

August 3, 2007

---

Date

PRE-APPEAL BRIEF REQUEST FOR REVIEW

**Mail Stop AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated below.

Applicants are in receipt of the Advisory Action mailed July 18, 2007. Claims 1-21 remain pending in the application. Reconsideration of the present case is earnestly requested in light of the following remarks. Please note that for brevity, only the primary arguments directed to the independent claims and certain dependent claims are presented, and that additional arguments, e.g., directed to the subject matter of the remaining claims, will be presented if and when the case proceeds to Appeal.

Claims 1-5, 8-12, and 15-19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Billington et al. (U.S. Patent No. 7,103,760) (hereinafter, “Billington”). Claims 6, 13 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Billington in view of Poomi et al. (U.S. Publication No. 2004/0064461) (hereinafter, “Poomi”), and claims 7, 14 and 21 as being

unpatentable over Billington in view of Hochmuth et al. (U.S. Publication No. 2003/0056063) (hereinafter, “Hochmuth”). The following clear errors in the Examiner’s rejection are noted.

**1. The Examiner acknowledges that Billington fails to anticipate the independent claims.**

Claim 1 recites a system comprising a server configured to execute an application; a stateless client configured to communicate with the server and further configured such that during use, a user interacts with the application via the stateless client; and a mass storage device locally coupled to the stateless client, wherein the mass storage device is accessible by the user via the server; where the server is further configured to store data to the mass storage device via the stateless client in response to the user’s interaction with the application.

In rejecting claim 1, the Examiner asserts that Billington discloses a thin client 12 having a locally connected mass storage device 80, citing Billington, Figure 11 and col. 13, line 19 to col. 14, line 16. The Examiner acknowledges that “Billington does not explicitly spell out how to store the data to mass storage [device] 80.” Final Action, p. 3. Applicants agree with the Examiner’s assessment in this regard. As noted by the Examiner, at col. 5, lines 50-57, Billington describes a thin client network that “facilitates concurrent use of the resources of one powerful PC by multiple users at thin clients.” Billington further describes, as noted above, that mass storage devices may be locally connected to a thin client.

However, none of these features, nor any other feature of Billington, amounts to a disclosure that a server is configured to store data to a mass storage device that is locally coupled to a stateless client in response to a user’s interaction, via the stateless client, with an application that the server is configured to execute, as required by claim 1. Applicants note that if Billington fails to “explicitly spell out” how data is stored to a mass storage device as acknowledged by the Examiner, Billington cannot possibly disclose the detailed recitation of claim 1 in which such storage occurs in response to a specific and detailed event involving the explicitly recited interoperation of several system components.

In the Advisory Action, the Examiner additionally quotes from Billington, col. 11, lines 28-39, which states that “digital video data can be transferred to the processor, to the connected mass storage device, to the printer to print out a still image, etc.” However, this passage of Billington refers to a completely different embodiment than the thin client embodiment discussed

above. In this passage, Billington is discussing an embodiment in which “the peripheral device 12 can comprise a printer having further devices 39a, 39b incorporated in the case 32.” Billington, Figure 4 and col. 11, lines 18-19, emphasis added. By contrast, the embodiment discussed at col. 13-14 refers to “an implementation of a hard-wired or wireless network where the peripheral 12 can comprise a thin client device.” Billington, col. 13, lines 20-22, emphasis added. A printer is not a thin client device, as Billington’s distinct treatment of these embodiments demonstrates. Thus, the interaction that a printer may have with a mass storage device is irrelevant to the interaction a stateless client may have with a server, an application, a user and a mass storage device as recited in claim 1.

## 2. The Examiner inappropriately argues that the absent claim features are “inherent.”

The Advisory Action states that “the Examiner believes that Billington directly or inherently anticipates all the limitations recited in [] claim 1.” Advisory Action, p. 4. Since the Examiner has acknowledged that Billington fails to explicitly disclose the recited manner in which the mass storage device operates, the Examiner must be asserting that these features are inherently taught by Billington. Indeed, in the Advisory Action, the Examiner asserts that “[t]he resources [of Billington] include mass storage devices and use of mass storage device is inherently for storing data to and reading data from it.” Advisory Action, p. 3. Also, in the Final Action, the Examiner asserts that “it is clear that the users of the thin clients use the resources provided by processor 14 comprising a server and the mass storage 80. The processor 14 uses peripheral devices including the mass storage 80 for storing data.” Applicants traverse the Examiner’s assertions.

According to MPEP 2112.IV, “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic,” citing *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). Further, “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” citing *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (internal citations omitted, emphasis added). Further, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the

allegedly inherent characteristic necessarily flows from the teachings of the applied prior art," citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

In contravention of the above requirements of law, the Examiner's assertions are merely assumptions regarding how Billington's system might operate that are unsupported by any positive disclosure within the Billington reference itself. That is, simply because the system of Billington might be capable of adaptation to include the features of claim 1 does not entail that the recitations of claim 1 necessarily, inherently follow from the system of Billington. As previously noted by Applicants, given Billington's acknowledged silence as to the specific manner in which data is written to mass storage device 80, a thin client 12 that interacts directly with mass storage device 80 without intervention of processor 14 would be perfectly consistent with Billington's teachings. However, such an embodiment would contradict the requirements of claim 1. Because Billington is consistent with an embodiment that would contradict claim 1, it is logically impossible that the features of claim 1 follow inherently and necessarily from Billington.

### **3. The standard of anticipation has not been met with respect to the independent claims.**

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. M.P.E.P. 2131; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

As demonstrated above, the Examiner has acknowledged that Billington fails to disclose certain elements of claim 1. Applicants have further demonstrated that the features of claim 1 that are absent from Billington do not follow inherently from Billington. Thus, Billington fails to meet the above standard with respect to claim 1 as well as similar independent claims 8 and 15. Therefore, Applicants submit that Billington cannot be said to anticipate the independent claims. Applicants further note that the remaining cited references do not remedy the omissions of Billington with respect to the independent claims.

In light of the foregoing remarks, Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested. If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 501505/5681-76100/RCK.

Also enclosed herewith are the following items:

Notice of Appeal

Respectfully submitted,

/Robert C. Kowert/

Robert C. Kowert, Reg. #39,255  
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.  
P.O. Box 398  
Austin, TX 78767-0398  
Phone: (512) 853-8850

Date: August 3, 2007